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David A. Cheresh

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID A. CHERESH, ROBERT PAUL, and BRIAN ELICEIRI

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Appeal 2006-2889  
Application 09/538,248  
Technology Center 1600

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Decided: January 9, 2008

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Before ERIC GRIMES, LORA M. GREEN, and  
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered February 26, 2007. That decision affirmed rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a).

Appellants argue that “the purported inherency is based on a ‘reasonable inference,’” which is not enough, as “inherency must be a necessary result and not a possible result.” (Req. Rhg. 2.)

Appellants’ request is denied. In making our determination, we applied the preponderance of the evidence standard. *See, e.g., Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office); *In re Kollar*, 286 F.3d 1326, 1329 (Fed. Cir. 2002) (“The PTO bears the initial burden of demonstrating that the preponderance of the evidence establishes, *prima facie*, facts supporting the conclusion that the claimed invention was on sale within the meaning of § 102(b).”).

As stated in the Decision on Appeal, Burchat 2000 established that compounds encompassed by the claims on Appeal were src kinase inhibitors (Decision 5). Burchat 2000 failed to expressly state that the compounds were inhibitors of human src kinase (*id.*). However, we found that as “Burchat 2000 was using human lck, human kdr and tie, . . . the reasonable inference is that Burchat is using human c-src, or that the results obtained with the src would have been reasonably expected to predict a compound’s activity on human src.” (*Id.*) Thus, the reasonable inference, *i.e.*, the preponderance of the evidence, supports our finding that the compounds taught by Burchat 2000 are inhibitors of human src kinase.

Appellants assert further that a “retrospective view of inherency . . . is not a substitute for some teaching or suggestion which supports the selection

. . . of the claimed subject matter.”<sup>1</sup> (Req. Rhg. 2.) However, “[i]nherency is not necessarily coterminous with knowledge of those ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1376 (Fed. Cir. 2005) (citations omitted).

#### CONCLUSION

We have considered Appellants’ Request for Rehearing, but decline to make any substantive change in our previous opinion.

#### REHEARING DENIED

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<sup>1</sup> Appellants rely on *In re Newell*, 891 F.2d 899 (Fed. Cir. 1989) for this principle. *Newell* was referring to inherency in the context of an obviousness determination, whereas the instant rejection is an anticipation rejection.